

REMARKS

Claims 22-46 are pending in the application. Claims 1-21 were previously canceled.

Reconsideration and review of the claims on the merits are respectfully requested.

Formal Matters

Applicants appreciate that the Examiner has acknowledged Applicants' claim for foreign priority and receipt of the priority document.

Double Patenting Rejection

Claims 22-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as assertedly being unpatentable over Claims 11,13,15 and 17 of copending Application No. 09/521,616.

Applicants respond as follows.

Without addressing the merits of the double patenting rejection, Applicants file concurrently herewith a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) to overcome this provisional rejection by showing that the conflicting application is commonly owned with this application.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the double patenting rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 22-46 are rejected under 35 U.S.C. 103(a) as assertedly being unpatentable over Cunningham et al (US 6,096,794) in view of Gottschalk et al (US 4,865,942) for the reasons given in the Office Action.

The Examiner concludes that it would have been *prima facie* obvious to one of ordinary skill in the art of photosensitive recording materials to use the borate compound as disclosed in Cunningham as a dye-borate photoinitiator in Gottschalk and reasonably expect same or similar results with respect to rapid polymerization for the photosensitive recording materials. Secondly, the Examiner asserts that it would have been *prima facie* obvious to the skilled artisan seeing the various applications as disclosed in Cunningham for image recording materials to use the Cunningham photopolymerizable composition in an image forming material such as disclosed in Gottschalk in the place of the photohardenable composition having a dye-borate complex, and reasonably expect same or similar results with respect to having photopolymerizable compositions which are sensitive at longer wavelengths.

Applicants respectfully traverse the rejection.

Applicants traverse the Examiner's *prima facie* case of obviousness. The combination of the two references still fails to teach each and every element of the present claims. For example, the Examiner does not address the critical molar ratio limitation in Claim 1 that at least one kind of an organoboron compound represented by general formula (I) be in a proportion of at least one mole per mole of the organic dye. Applicants re-emphasize that this range is critical to

achieving the present invention which is characterized by radical decolorization of the initiator dye after exposure polymerization.

For support of criticality, Applicants disclose in the specification that the ratio between the organic dye and the organoboron compound is very important from the standpoint of obtaining high sensitivity and sufficient decolorization by the irradiation of light in the fixing step. If the amount of the organoboron compound to be added is less than 1 mole per mole of the organic dye, sufficient polymerization reactivity and decolorization cannot be obtained (see page 20, lines 5-26). Thus, in the present invention, improvements in several properties such as sensitivity, storability, photo-fixability, and decolorization of organic dyes can be obtained by use of the organoboron compound in an amount exceeding 1 mole per mole of the organic dye. (see results in Table 1, page 119).

In contrast, neither Cunningham '794 nor Gottschalk '942, individually or in combination thereof, makes any mention of the criticality of any particular molar ratio. Examples in Cunningham '794 do not satisfy the molar ratio limitation in Claim 1. Most of the molar ratios of the examples in Cunningham '794 are lower than 1. Furthermore, Cunningham makes no mention of criticality of any particular molar ratio and does not appreciate every element of the present invention, and makes no mention that such properties as sensitivity, storability, photo-fixability, and decolorization of organic dyes are improved by use of the organoboron compound in an amount exceeding 1 mole per mole of the organic dye. This means that Cunningham did not realize the importance of the molar ratio exceeding 1. The secondary reference to Gottschalk fails to remedy Cunningham's failure to disclose or suggest such critical molar range.

RESPONSE UNDER 37 C.F. R. § 1.111
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Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a).

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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